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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/092,638	03/08/2002	Yaguang Liu		8472

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12/23/2003

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EXAMINER

TATE, CHRISTOPHER ROBIN

ART UNIT	PAPER NUMBER
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1654

DATE MAILED: 12/23/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/092,638

Applicant(s)

LIU, YAGUANG

Examiner

Christopher R. Tate

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 02 June 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) 2-27 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Applicant's election of Group I, claim 1, in Paper No. 3 is acknowledged.

Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)). Claim 1 is presented for examination on the merits.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 1 is rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a process of preparing resveratrol and derivatives thereof which is used to treat and/or reduce the risk of cancer, does not reasonably provide enablement for the use of such a prepared compound to prevent cancer (as instantly recited in the preamble language). The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to use the invention commensurate in scope with these claims.

Applicants have reasonably demonstrated/disclosed that the claimed compound (and derivatives thereof) is useful as a therapeutic agent for treating cancer and/or reducing the risk thereof. However, the claims also encompass using the claimed compound (and derivatives thereof) to prevent cancer which is clearly beyond the scope of the instantly disclosed/claimed invention. Please note that the term "prevent" is an absolute definition which means to stop from occurring and, thus, requires a higher standard for enablement than does "treat", especially with

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respect to preventing cancer (which, is not recognized in the medical art as being totally preventable).

It is suggested that the preamble be amended by replacing the phrase "which used for prevention of cancer" with --which is used to treat and/or reduce the risk of cancer-- to overcome this rejection.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 is replete with grammatically confusing phrases and/or missing terms which makes it difficult to interpret. The following are few examples of vague and indefinite recitations throughout the claim:

- The phrase "and its derivate" (line 1) is unclear – i.e., the metes and bounds of the term "derivate" are not clearly nor adequately delineated. For example, a derivative could be a singular carbon atom, a branched chemical segment, and/or a non-active fraction therefrom. Further, the instantly claimed process (as well as the teachings of the instant specification) appears to be drawn to producing the compound resveratol, per se, not derivatives thereof. In addition, it is unclear as to which and how many derivatives are envisioned by this term. It is, therefore, suggested that this phrase be omitted from the claim language.

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- Past tenses used in conjunction with present tenses (e.g., "was", "filtrated", "concentrated", "added", "dissolved", "dried", "is", to name a few). Please note that, for proper definition, the claim terms should all be present tense.
- There are numerous instances of step recitations which lack sufficient antecedent basis, or which fail to properly refer to a previously obtained intermediate product (e.g., said filtrate, said residue, or the filtrate, the residue, to name a few) making it unclear as to which intermediate product is actually being defined. Examples include: "oil residue" (step a), "mix solution" (step b); "filtercake" (step c); "filtrate" (step d), "ethyl ether" (step f), "residue" (step g), "water solution" (step h), "filtrate" (step i), "filtrate" (step j), "filtrate" (step k), "filtrate" (step l), "filtrate solution" (step m), "the crystal" (step n), "crystal" (step o), "solution" (step p), "water solution" (step q), "white crystal" (step r), "crystal" (step s), "the final product" (step t).
- There are numerous phrases which are grammatically confusing (particularly with respect to missing verbs) – e.g., "which used for prevention" (line 1); "and still residue was obtained" (step d), "extracted by solution" (step e), "recovered under reduced pressure and still residue was obtained" (step f), "hot water added to residue" (step g), "active carbon added" (step i), "and filtrate was saved" (step j), "ethyl ether added ...for crystallized" (step m), "crystals dissolved" (step o), "white crystal was collected" (step r), "crystal dried" (step s).

Claim 1 is free of the art. The prior art of record does not teach nor reasonably suggest a process of producing resveratol via the claimed method steps.

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It is suggested that Applicant contact the Examiner (see contact information below) for guidance on amending claim 1 in order to place the claim in condition for allowance. In addition, to hasten prosecution, it is suggested that Applicant cancel non-elected claims 2-27 in response to this Office action.

Conclusion

No claim is allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher R. Tate whose telephone number is (703) 305-7114 [please note that as of Jan 20, 2004, the examiner's phone number is being changed to (571) 272-0970]. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brenda Brumback, can be reached at (703) 306-3220 [please note that as of Jan 20, 2004, the supervisor's phone number is being changed (571) 272-0961].



Christopher R. Tate
Primary Examiner, Group 1654